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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Howard Dernehl

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3688

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/635,994	Applicant(s) DERNEHL ET AL.	
	Examiner Raquel Alvarez	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12,13,15-21,23,27-30,34-36,40,41 and 43-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12,13,15-21,23,27-30,34-36,40,41 and 43-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to communication filed on 4/28/2008.
2. Claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41 and 43-51 are presented for examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 45 depends from canceled claim 42. Correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40, 41 and 43-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **article titled, “recommend-it.com”** in view of “How MileNet Works” hereinafter MileNet .

With respect to claims 1-4, 7-13, 15-16, 19, 27, 40-41, 46-51, recommend it.com teaches a method of marketing comprising the steps of a first party recommendation, the recommendation comprising forwarding of a first e-mail message to a second party, the first message comprising a personalized referral

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and a first set of data, the first set of data comprising a first serial number and a first URL link to a first web site having an offer to transact (i.e. the first user will send an e-mail to a friend or colleague detailing the site and would include a short description identifying advertisements)(page 2); correlating the first set of data in the first e-mail message to data within a database (page 2); updating the database with an e-mail address of a second party provided by the first party (pages 1-4); forwarding the first e-mail message to the e-mail address of the second party (see page 4).

With respect to the recommendation being selected from a group consisting of goods and services. Recommend.it.com teaches recommending the recommend-it website. Recommend.it.com doesn't specifically teach selecting from a group of goods or services. Official Notice is taken that it is old and well known to allow users to select different products or services in order to provide variety. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included selecting from a group consisting of goods and services in order to achieve the above mentioned advantage.

With respect to providing data related to a reward and providing the reward to the first party if the second party transacts the exchange from the marketable entity. MileNet teaches a pyramid type of incentive wherein the first user will increase their MileNet points based on the first user recommendation. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing data related to a reward and

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providing the reward to the first party if the second party transacts the exchange from the marketable entity in order to motivate the users to increase their rewards based on their friends and families actions.

With respect to the recommendation resulting in the purchase of a marketable entity. Recommend-it.com and Milentet teach the second users receiving ads containing advertisements. Advertisements are well known to entice a user to make a purchase. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the recommendation resulting in the purchase of the presented advertisements in order to further generate revenues.

With respect to the newly amended feature of first user purchasing the marketable entity and then recommending the purchased marketable entity and offering the reward to the first user when the second user purchases the marketable entity. Official notice is taken that it is old and well known, in chain referral sales, multi-level business pyramids or the like for a seller, institution or the like to induce an existing customer to give out the names of their friends and family by promising the existing customer a discount or a rebate if the customer furnishes the seller with the names of other prospective buyers. In certain cases, the rebate is paid only if the prospective buyer actually makes a purchase. For example, Banks and the like will give existing customer discounts if the existing customer recommends a family or friend that becomes a member of the institution. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included given an incentive or discount

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to an exiting customer if the customer recommends a person that makes a purchase with a seller in order for the seller to only give discounts for purchases that result in sale.

Claims 6, 17-18, 20, further recite that the link is accessible through a token in the form of a first icon visible in the message. Official notice is taken that it is old and well known in the computer related field to have a token in the form of an icon that is visible in the message in order to represent a function, object or program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a token in the form of a first icon visible in the message in order to make file navigations and manipulation easier.

Claims 21-23, 28-30, 34-36, 43-45 further recite crediting an account within a database and recording the reward credited. Official notice is taken that it is old and well known in the business related arts to credit an account because such a modification would provide an easy and efficient way to reward a customer. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included crediting an account within a database and recording the reward credited in order to obtain the above mentioned advantage.

Response to Arguments

7. Applicant argues that there is no hint, teaching, or suggestion within recommend-it that the first user only receives a reward once a purchase is made by a second user, where the purchase by the second user is in response to a recommendation sent by the first user. The Examiner wants to point out that the Examiner has taken Official Notice that is well known for an existing customer to recommend a person to a service that he or she is familiar with and for the customer to receive a reward when the recommended user signs up for the service. For example, Banks and the like will give existing customer discounts if the existing customer recommends a family or friend that becomes a member of the institution such a modification would allow the institution to give away incentives to existing customers that recommend prospective customers that results in sale.

8. Applicant argues that the claimed limitations are still further differentiated from the combination of recommend-it and MileNet in that two separate purchases are made. First, the first party must make a purchase in order to be eligible to make the recommendation. Specifically, the claimed limitations are directed to "transacting a purchase for a marketable entity by a first party" and "offering a reward to the first party in response to the first party purchasing the marketable entity." The first party is only provided the opportunity to make the recommendation in response to the first party making the purchase of the marketable entity to be recommended. Second, the first party is only provided the

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reward once the second party makes a purchase of the marketable entity recommended by the first party. The Examiner wants to point out that the Official Notice cited meets this limitations. As pointed above, Banks and the like will take recommendations from existing customers and will give their existing customers an incentive such as free checking if the person recommended by the existing customer becomes a member with the institution.

9. Applicant argues that recommend-it and MileNet teach against purchasing a marketable entity because both recommend-it and MileNet explicitly teach a free service. The Examiner wants to point out that recommend-it and MileNet do not teach away for making purchases because as clearly taught by MileNet, the website makes money from the advertisers and therefore motivating users to make purchases by the use of advertisements on the recommended website. Although, the purchases are not for the marketable entity (i.e. Web Deck software per se), the references do not teach away from making purchases in general. In addition, the Examiner wants to point out that the claims were rejected under the doctrine of 103.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
7/30/2008